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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/655,987	09/06/2000	Calvin B. Ward	54391	9378

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EXAMINER

DICUS, TAMRA

ART UNIT	PAPER NUMBER
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1774

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DATE MAILED: 12/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/655,987

Applicant(s)

WARD, CALVIN B.

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 9-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 19-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgement is made of response to Restriction requirement. The Examiner acknowledges election of claims 1-8 and 19-28. Claims 9-18 are drawn to non-elected invention and withdrawn from consideration at this time.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 19-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims address a "composition". The specification does not teach the invention of a composition, but a layered sheet. Therefore, the claims will be regarded as such.

Applicant is advised that should claims 1 and 19 be found allowable, claims 1 and 19 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not defined or described in the specification as to how the barrier is in “an appropriate pattern”.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-2, 19-20, and 27-28 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 4,312,907 to Hiraoka et al.

Hiraoka teaches a water-impermeable sheet material comprised of a fiber sheet substrate (woven or non-woven (inherently has plurality of cells), artificial fiber may consist of polyesters such as PET, nylon 6) (encompasses absorbent layer since it functions as one having absorbing quality) with a porous water-impermeable layer comprised of hydrophobic polymeric material impregnated with paraffin wax. Hiraoka describes the pores may be formed by several methods inclusive of an electrical discharge pore-forming operation (electrostatically charged sheet) or pores formed using a foaming agent. See col. 3, lines 5-30, col. 5, lines 43-66, col. 6, lines 40-48, and Figures 1 and 4. At col. 3, lines 45-55, the water-impermeable layer may be bonded via a heat-calendar or laminating machine. The limitation that the absorbent layer is “for containing liquid spilled on said absorbent layer” is not a patentable limitation. Since it has been held that a

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recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claim 2, the fiber sheet may comprise paper such as cellulosic material. See col. 4, lines 1-10.

7. Claims 1, 2, 5, 19, 27, 28, 20, and 23 rejected under 35 U.S.C. 102(b) as being anticipated by Babb et al.

Babb teaches a composite laminate sheet comprising a layer of polymeric material such as perfluorocyclobutane adhering to nonwoven or woven porous layers of paper, fibrous glass mats, or polyester material (absorbent layer with a plurality of cells). The outer layer may provide adhesion characteristics via a surface treatment such as a corona discharging method (providing an electrostatically charged sheet). The limitation that the absorbent layer is "for containing liquid spilled on said absorbent layer" is not a patentable limitation. Since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). See col. 2, lines 1-65, col. 13, line 45- col. 14, line 5, and col. 15, lines 25-60.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-8 and 19-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4,797,310 to Barby et al. in view of USPN 4,312,907 to Hiraoka et al., USPN 3,709,221 to Riely.

Barby teaches an article for absorbing liquid or delivering liquid. Barby's article comprises an upper and lower substrate where both can be either of a nonwoven fabric or wet-strength paper (either may function as an absorbent layer) (regarding claims 2 and 20). Both substrates may be laminated to a polyethylene or polypropylene film and both have a grid pattern (hydrophobic barriers regarding claims 7 and 25) comprising a plurality of compartments (plurality of cells). The substrates are bonded by a heat seal (regarding claims 1, 19, and 27-28). Refer to col. 2, lines 16-25, col. 14, lines 1-30, and Examples 34, 35, and 53.

Barby does not teach an electrostatically charged sheet or electrostatically charging a foam or fibrous mat (addressing claims 1, 3, 4, 6, 19, 21, 22, 24, 27, and 28). However, as described above, Hiraoka teaches forming an electrostatically charged sheet or foam. Barby and Hiraoka are analogous art because both references are in the same field of endeavor, such as laminated substrate technology. Hence it would have been obvious to one of ordinary skill in the art to modify the article of Barby to modify a sheet to become an electrostatically charged sheet since Hiraoka teaches polymeric material may be electrically charged to form pores, fibrous material, or foam as taught at col. 6, lines 40-48 for the purpose of decreasing the heat conductivity of the sheet material at col. 6, lines 49-54. Also Hiraoka teaches in col. 6 that the electrically charged sheet also prevents the condensation of moisture. Applicant uses the

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electrostatically charged sheet for the same purpose. Further regarding foam and fibrous mat being electrostatically charged, these limitations are process limitations in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531.

Barby does not explicitly define an open foam cell sheet. Hermann teaches foam polymerization to form an open cell foam substrate at col. 6, lines 55-65 for providing extra strength to a material. Therefore, it would have been obvious to one of ordinary skill in the art to modify the article of Barby to include an open cell foam since Hermann teaches doing so provides extra strength to a material. See Figure 1.

Barby does not explicitly state incorporating the fibrous mat of claims 6 and 24. Riely teaches a microporous nonadherent surgical dressing comprising a sheet of polyester film having a porous open celled structure and an absorbent material of wood pulp fibers (paper) can be formed of mats or pads of fibers (fibrous mat). See col. 1, line 55 - col. 2, line 14, and col. 5, lines 1-15. Hence it would have been obvious to one of ordinary skill in the art to modify the article of Barby to include a fibrous mat since Riely teaches forming a fibrous mat results in a greater absorptivity per volume of absorbent material at col. 5, line 30.

Further regarding claims 8 and 26, that the pores are "allowing liquid spilled...", is not a positive recitation and does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPN 4,850,991 to Nakanishi et al. teaches a liquid-permeable top sheet comprising an absorbent layer. USPN 4,411,928 to Baldwin teaches cellulosic paper and polyester as a non-woven substrate. USPN 4,664,971 to Soens teaches a plastic article that is electrically conductive by impregnating with electrically conductive fibers. USPN 5,609,587 to Roe teaches a diaper having a top sheet of impregnated paraffin wax and polyester. USPN 6,103,644 to Sheridan teaches a polymeric fibrous matrix impregnated with a composition. USPN 5,855,999 to McCormack teaches a cloth-like film or nonwoven of a polypropylene resin bonded to a film. USPN to Andersen et al. teaches a laminate of porous impermeable or permeable outer cover sheets bonded to nonwoven or paper or inorganically filled sheets providing barriers within.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is (703) 305-3809. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 746-8329 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Tamra L. Dicus
Examiner
Art Unit 1774

December 10, 2002

GISELA H. KELLY
SENIOR PATENT EXAMINER
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